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David G. Rosenbaum			EXAMINER	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/672,695

Filing Date: September 26, 2003

Appellant(s): BOYLE ET AL.

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Group 3700

Paul J. Lee  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 7/19/2007 appealing from the Office action mailed 8/18/2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner, which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

1. U.S. Patent Application Serial No. 09/707,685 to Palma et al., for Endoluminal Stent, Self-Supporting Endoluminal Graft and Methods of Making Same, filed on November 7, 2000. (Attorney Docket No. 6006-015)

2. U.S. Patent Application Serial No. 09/716,146 to Boyle et al., for Device for In Vivo Delivery of Bioactive Agents and method of Manufacture Thereof, filed on November 17, 2000. (Attorney Docket No. 6006-018)

3. U.S. Patent Application Serial No. 09/783,633 to Bailey et al., for In Vivo Sensor and Method of Making Same, filed on February 14, 2001. (Attorney Docket No. 6006-009)

4. U.S. Patent Application Serial No. 10/258,087 to Boyle et al., for Device for In Vivo Delivery of Bioactive Agents and Method of Manufacture Thereof, filed on August 19, 2003. (Attorney Docket No. 6006-070)

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

EP 0 759 730 B1	Burmeister	11-1995
6,585,764 B2	Wright et al	7-2003

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-12, 15, 18-24, 26-27, 29-31, and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Publication EP 0 759 730 B1 Burmeister in view of United States Patent 6,585,764 B2 Wright et al.

Burmeister discloses the same invention being an implantable endoluminal graft comprising a nitinol thin film covering (34) having uniform pattern of elongated slots (figure 11a and 11b) and an underlying nitinol structural support element (32) that have multiple affixation elements throughout the device along the support elements cylindrical sinuous elements and the affixation projections shown in figures 1-16. Burmeister further discloses that the film covering remains in a martensite crystalline structure throughout the temperature transition from room temperature to body temperature and that the support structure undergoes a martensite to austenite phase transition during a transition from room temperature to body temperature. However, Burmeister does not disclose that the thin film covering comprises a microporous surface.

Wright teaches the use of an implantable stent comprising a microporous outer surface in the same field of endeavor for the purpose of providing a drug delivery device.

Art Unit: 3738

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the microporous outer surface as taught by Wright with the implant of Burmeister in order to deliver a drug to the implant site.

#### **(10) Response to Argument**

The applicant argues that Burmeister fails to disclose a thin metal covering and a structural support layer. The examiner acknowledges that Burmeister discloses that his product may be made without 2 distinct layers, but this is just one embodiment. The basic invention of Burmeister clearly provides 2 distinct layers clearly shown in figure 3 and referenced by numbers 32 and 34. The attorney's argument with relation to this is not persuasive because all the cited support from Burmeister clearly says, "need not", which is support in itself that there is an embodiment with the two distinct layers. Furthermore since there is no distinguishing structure claimed for the support stent and the metal film layer the examiner is well within his right to call the outer layer 34 a thin metal film and then inner layer 32 a support layer. The applicant also argues that Burmeister discloses the outer layer outside of the range desired by the applicant. However the applicant has failed to provide any claim language that specifies a desired thickness for either layer.

The applicant then argues that neither Write nor Burmeister disclose a microporous layer. The applicant argues a proposed definition of microporous, but fails to provide a place in the specification wherein there is a definite definition of the term. The proposed definitions from the specification fail to directly define microporous. The

Art Unit: 3738

specification describes openings not the term microporous. Even so the openings simply require that particles pass through them, which does not require the particles to pass out the other end of the opening. Moving from the top to the middle of an opening meets the criteria for passing through an opening. In view of the lack of a definition for microporous the pores of Write qualify as an equivalent structure. The applicant specifically argues against this saying that the pores of Write "do not transverse the thickness of the structural element", but this language fails to appear within the claims.

The applicant then argues that Burmeister fails to disclose an affixation member, a point of attachment, or a projection. However the two layers of Burmeister are completely bonded together throughout their surface areas. This intersection of the two members is considered to be the affixation member, which is the entire top surface of the inner layer and the entire bottom surface of the outer layer. Furthermore claim 18 recites that there is at least one point of attachment, which allows for there to be multiple points of attachment. Burmeister however only has a single uniform point of attachment throughout the contacting surfaces of the inner and outer layers. In regards to the projection requirement, the frame of Burmeister comprises a plurality of longitudinal projections cut into the frame of his implant an example is shown as the branches at each of figure 1. Each end of the frame has a plurality of branches that project away from the implant and within these branches is the affixation member located at intersection of the inner and outer surface.

Applicant's arguments with respect to claims 1-6, 8-12, 15, 18-24, 26-27, 29-31, and 34-35 have been considered but are moot in view of the new ground(s) of rejection. However the applicant's argues that Burmeister fails to teach an affixation member. The claims recite that there is only a need for at least one affixation member, but this also allows or a plurality. The framework of Burmeister is being interpreted as having a plurality of affixation member, which are located at all points of contact between the film and the framework.

#### (11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Christopher Prone



Conferees:

Corrine McDermott

Thomas Barrett



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